

REMARKS

Initially, Applicant thanks the Examiner for his suggestions to eliminate informalities in claims 28, 29, 49
5 and 35. Said claims have been amended in accordance with the Examiner's comments. Applicant believes that the foregoing amendments to the claims and the comments that follow will convince the Examiner that the rejections provided in the December 11, 2001 Office Action have been
10 overcome and should be withdrawn.

I. THE INVENTION

Hair color is used by a large percentage of the population. The reasons consumers may color hair vary from
15 a desire to change hair color, over grey hair, or provide unique highlighting effects. In addition, certain funky looks which are popular with young people include "streaking" or "chunking", where different segments of the colored hair show substantial shade variations.

20 The traditional procedure for achieving streaked or chunked hair, as well as hair exhibiting more subtle variations in tonality and hue, comprise two steps: The hair is first bleached. The second step involves coloring the hair with the desired hair color. This two step

process is disadvantageous because the bleach step often results in uneven removal of color from the hair and the hair is not colored in the desired shade. In addition, the process takes twice the time, and may require heat, thus
5 may cause increased damage to overly sensitive hair as both the bleach and the colorant are most often highly alkaline, and are on the hair consecutively. This current method is particularly disadvantageous for African Americans who wish to chunk or highlight fragile hair that may already have
10 been relaxed or straightened.

The present invention discloses an improved composition for simultaneously coloring and highlighting hair. Compositions of the present invention comprise the following: inorganic persulfates, hydrogen peroxide, and
15 cationic dyes. By mixing these components just prior to application to the hair, applicants have avoided the stability problems associated with prior art compositions and have provided a one-step bleaching/coloring composition that represents a significant advance in the field.

20 The present invention also encompasses a method for simultaneously coloring and highlighting hair with the disclosed composition. The first step involves combining inorganic persulfates (in powder form) with an aqueous developer composition and an aqueous colorant composition.

The aqueous developer composition and aqueous colorant composition comprise hydrogen peroxide and cationic dye, respectively. The next step is applying the mixture to hair for a period of time sufficient for coloring and
5 highlighting.

II. THE EXAMINER'S REJECTIONS

The Examiner has rejected claims 33-40, 49, and 54 under 35 U.S.C. § 112 as being indefinite. In particular,
10 claim 33 was rejected because of the inclusion of the phrase "generally inert particulate." The Examiner concluded that "one of ordinary skill in the art would not be able to ascertain the metes and bounds of the term 'generally'." (paragraph 6) Further, claim 49 was rejected
15 for including C₁₂ isoparaffins with volatile silicones. Finally, claim 54 has been rejected for including trademarks/trade names.

Additionally, the Examiner rejected claims 25, 59, and 60 under 35 U.S.C. § 102(b) as being anticipated by Henkel.
20 The Examiner indicates that Henkel "teaches a three part blonding mixture for hair . . . The first part comprises . . . a cationic dye as claimed (Brilliant Blue R 28032) in the claimed amounts . . . The second part comprises a 6% solution of hydrogen peroxide, and the third part comprises

solid (i.e. powdered) ammonium persulfate." (paragraph 10)
Therefore, the Examiner argued that claims 25, 59, and 60
are anticipated by Henkel.

Also, the Examiner has rejected claims 26-42 under 35
5 U.S.C. § 103(a) as being unpatentable over Henkel. The
Examiner explains that Henkel further teaches "that the
solid persulfate composition may also contain 1-8% by
weight of fillers, including those which read on the
claimed inorganic colorants." Also, "Henkel teaches the
10 equivalence between ammonium and sodium and potassium
persulfate as claimed . . . The persulfate, developer and
colorant compositions are mixed in the claimed amounts, and
are applied to hair for the claimed times followed by
rinsing." (paragraph 11) The Examiner then argues that the
15 claimed composition of the present invention is expressly
suggested by Henkel.

Further, the Examiner rejected claims 25-47, 50-53,
and 55-68 under 35 U.S.C. § 102(a) as being anticipated by
Goldwell. Goldwell teaches a three part composition
20 (comprised of compositions A1, B1, and C) for coloring and
brightening hair. Colorant composition A1 "comprises
cationic dyes, a cationic surfactant, and a protein
derivative (wheat protein hydrolyzate) as claimed in the
claimed amounts, and humectants as claimed (PEG

derivatives)." Powdered composition B1 "comprises ammonium and potassium persulfate and particulate fillers (e.g. pyrogenic silica) in the claimed amounts, an inorganic colorant (magnesium oxide), and a paraffin oil."

5 Composition C comprises hydrogen peroxide, water and an oily phase (cetyl stearyl alcohol) in the claimed amounts."

(paragraph 12) In practice, the three compositions are mixed with water, applied to the hair, and then rinsed from the hair. Furthermore, the Examiner stated that the
10 composition may be applied as an emulsion.

Also, the Examiner rejected claims 48 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Goldwell in view of Yoshihara. Yoshihara teaches keratinous fiber treating compositions. These compositions are preferably cationic
15 or basic direct dyes. "Yoshihara teaches that silicones are preferably added to the compositions in the claimed amounts in order to improve the texture of the hair."
(paragraph 13)

20 III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

In response to the Examiner's rejections of claims 33-40, 49, and 54 under 35 U.S.C. § 112, Applicant has amended claim 33 to simply describe said particulate as "inert." Claims 34-40 depend on claim 33 and therefore, are also no

longer indefinite. Claim 49 has been amended such that C₁₂ isoparaffins are no longer included therein. Applicant has added claim 98 to correctly claim the use of C₁₂ isoparaffins as hydrocarbon oils. Additionally, claim 54
5 has been amended such that no trademarks or trade names are included therein. Thus, all cited claims are no longer indefinite.

Regarding the Examiner's rejections of claims 25, 59, and 60 under 35 U.S.C. § 102(b) as being anticipated by
10 Henkel and claims 26-42 under 35 U.S.C. § 103(a) as being unpatentable over Henkel, Applicant has amended claim 25 to require that the components of the disclosed composition be mixed immediately prior to use. The only purported invention of Henkel is the discovery that two particular
15 direct blue dyes, namely brilliant blue R 28032 and lilac R 5283, are stable in bleaching compositions and are well absorbed by the hair. This narrow invention bears little or no resemblance to the present application. Applicant recognizes that hair bleaching/highlighting compositions
20 are inherently unstable. Applicants avoids this well-recognized problem by mixing the components just prior to use. This is an opposite approach to Henkel's search for stable dyes, and it allows applicants to color hair any desired shade while Henkel is limited to platinum blond.

It is probably fair to say that Henkel is merely a non-yellowing bleach rather than a true hair colorant like the present invention. Consequently, claims 26-42, 59, and 60 are neither anticipated nor obvious in light of Henkel.

5 Also, the Examiner has rejected claims 25-47, 50-53, and 55-68 under 35 U.S.C. § 102(a) as being anticipated by Goldwell. It is black letter law that to be anticipatory, a prior art reference must disclose each and every element of the claim or claims at issue. However Goldwell does not
10 disclose a principle improvement disclosed by the current application. Goldwell relies on a combination of a xanthene-based hair dyeing agent, a peroxide based developer, and a persulfate based bleaching compound. The current application discloses that xanthene-based
15 compositions are not suitable for use by the large number of individuals who have sensitive or treated hair.

Goldwell discloses a composition which contains xanthan gum, thereby falling outside the scope of the current invention, which specifically excludes such
20 compositions. Goldwell is virtually identical to Japanese Patent Publication No. 08175940 (cited in the current application on page 2), since both disclose a product containing a xanthene-based dyeing agent, not suitable for use by those with sensitive or chemically treated hair.

Therefore, claims 1-4 cannot be anticipated by Goldwell, because Goldwell discloses a composition containing xanthan gum, a disadvantage of the prior art which this invention was specifically designed to overcome.

5 Furthermore, the Examiner rejected claims 48 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Goldwell in view of Yoshihara. This combination would only be proper if supported by the references themselves. However, Goldwell and Yoshihara both fail to support the
10 combination. Quite frankly, these references are unrelated to each other. Moreover, even if the Examiner's reliance on Yoshihara and Goldwell was proper (of course, Applicant believes that it is not), the Examiner still needs to rely on Applicant's specification to supply additional elements
15 that are completely absent from either reference. This is simply not proper.

 The Examiner claims that Yoshihara teaches the addition of silicones to hair colorant compositions results in improved hair texture. The Examiner claims it would
20 then have been obvious to one of ordinary skill in the art at the time of invention to add silicone to hair colorant products in view of Goldwell and Yoshihara. The Examiner's emphasis on Yoshihara is misplaced as well. Neither discloses a method for applying a single composition to

hair for coloring purposes. Further, although the Examiner claims that Yoshihara teaches that silicones are added to hair care compositions to improve hair texture, the elements of the underlying claim are absent from Yoshihara, 5 which claims a dialkylene glycol monoalkyl ether, an aromatic alcohol, and a weak acid. In short, Yoshihara adds nothing to the glaring deficiencies of Goldwell.

10 Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of 15 references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original).

20 The Examiner contends that it would be obvious to combine the teachings of Goldwell and Yoshihara to arrive at the applicants invention. This combination is not legally proper. On reconsideration the Examiner will 25 undoubtedly recognize that it is actually an "obvious to try" argument. Of course, "obvious to try is not the standard for obviousness under 35 U.S.C. § 103. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, we respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law.

Applicant submits that the only "motivation for the Examiner's combination of references is provided by the teachings of the Applicant's disclosure. No such motivation is provided by the references themselves; nor could there be in view of the difference in subject matter.

CONCLUSION

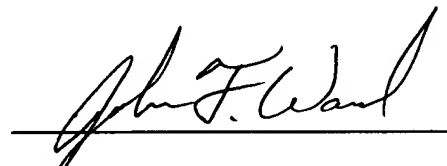
In view of the foregoing, Applicant respectfully submits that the present invention represents a patentable
5 contribution to the art, and the application is in condition for allowance. Early and favorable action is accordingly solicited.

Respectfully submitted,

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Date: _____

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MARKED-UP VERSION OF AMENDED CLAIMS

--25. (AMENDED) A composition for simultaneously coloring and highlighting hair, said composition comprising:

5 a powder bleach composition;

 an aqueous developer composition; and

 an aqueous based hair colorant comprised of one or more cationic dyes;

wherein said components are mixed together just prior to
10 application to the hair [said aqueous based hair colorant comprises a cationic dye].

28. (AMENDED) A composition according to claim 26, wherein said persulfate compounds comprise [alkalai] alkali metals
15 or alkaline earth metals.

29. (AMENDED) A composition according to claim 28, wherein said [alkalai] alkali metals are selected from the group consisting of: lithium, sodium, potassium, and cesium.

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33. (AMENDED) A composition according to claim 32, wherein said particulate fillers are [comprise a generally] inert [particulate].

35. (AMENDED) A composition according to claim 34, wherein said particulate fillers are comprised of inorganics, inorganic salts, hydrophilic colloids, carbohydrates, soaps, or alkyl sulfates.

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49. (AMENDED) A composition according to claim 48, wherein said volatile silicone is selected from the group consisting of: octamethylcyclotetrasiloxane, decamethylcyclopentasiloxane, and hexamethyldisiloxane[, and C₁₂ isoparaffins].

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54. (AMENDED) A composition according to claim 53, wherein said alkoxilated alcohol is selected from the group consisting of:

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products of a reaction of behenyl alcohol and ethylene oxide, wherein the number of repeated ethylene oxide units is 5 to 30;

products of a reaction of cetyl alcohol, stearyl alcohol and ethylene oxide, wherein the number of repeating ethylene oxide units is 2 to 100; or

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products of a reaction of cetyl alcohol and ethylene oxide, wherein the number of repeating ethylene oxide units is 1 to 45. [Beheneth 5-30, Ceteareth 2-100 and Ceteth 1-45.]--